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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/554,855	10/18/2006	Kenji Otda	49288.1600	4197
2022 7590 09/15/2009 SNELL & WILMER L.L.P. (Main) 400 EAST VAN BUREN ONE ARIZONA CENTER PHOENIX, AZ 85004-2202				
EXAMINER				
DENTER, CLARK F				
ART UNIT		PAPER NUMBER		
3724				
MAIL DATE		DELIVERY MODE		
09/15/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/554,855

Applicant(s)

OTODA ET AL.

Examiner

Clark F. Dexter

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-54 and 56-96 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-6, 8-54 and 56-96 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S5108)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The response filed on May 19, 2009 has been entered. In view of the amendments made to the claims, a revised Lack of Unity requirement along with applicant's new election based on this revised requirement is necessary. Specifically, the amendments require the addition of Group VIII as described below.

Election/Restrictions

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 2-6, 29, 32-37, 50-54, 80-85, drawn to a system/method with a specific pressing means configuration.

Group II, claims 8-14, 32 38-44, 56-62, 80, 86-92, drawn to a system/method with a specific holding means configuration.

Group III, claims 15, 16, 32, 45, 46, 63, 64, 80, 93, 94, drawn to a system/method with a second and third holding means.

Group IV, claims 17, 32, 47, 65, 80, 95, drawn to a system/method with a fourth and fifth holding means.

Group V, claims 18-24, 66-72, drawn to system method with a scribing line forming means including laser beam irradiating means and cooling means.

Group VI, claims 25-28, 73-76, drawn to a system/method with a scribing line forming means including a cutter.

Group VII, claims 31, 79, drawn to a system/method with a multiple scribing line forming devices.

Group VIII, claims 30, 48, 77, 78, 96, drawn to a system method with a combination of a specific pressing means configuration and a scribing line forming means.

3. Claim 1 links inventions I-VIII. The restriction requirement of the linked inventions is **subject to** the nonallowance of the linking claim(s), claim 1. Upon the indication of allowability of the linking claim(s), the restriction requirement as to the linked inventions **shall be withdrawn** and any claim(s) depending from or otherwise requiring all the limitations of the allowable linking claim(s) will be rejoined and fully examined for patentability in accordance with 37 CFR 1.104 **Claims that require all the limitations of an allowable linking claim** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.
4. Claim 49 links inventions I-VIII. The restriction requirement of the linked inventions is **subject to** the nonallowance of the linking claim(s), claim 49. Upon the indication of allowability of the linking claim(s), the restriction requirement as to the linked inventions **shall be withdrawn** and any claim(s) depending from or otherwise requiring all the limitations of the allowable linking claim(s) will be rejoined and fully examined for patentability in accordance with 37 CFR 1.104 **Claims that require all the limitations of an allowable linking claim** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier.

Amendments submitted after final rejection are governed by 37 CFR 1.116;
amendments submitted after allowance are governed by 37 CFR 1.312.

Applicant(s) are advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, the allowable linking claim, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

5. The inventions listed as Groups I-VIII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Group I is directed to a system/method with a special technical feature of a specific pressing means configuration that is not required in any of Groups II-VIII.

Group II is directed to a system/method with a special technical feature of a specific holding means configuration that is not required in any of Groups I and III-VIII.

Group III is directed to a system/method with a special technical feature of an additional two holding means that is not required in any of Groups I, II and IV-VIII.

Group IV is directed to a system/method with a special technical feature of a further additional two holding means that is not required in any of Groups I-III and IV-VIII.

Group V is directed to a system/method with a special technical feature of a scribing line forming means that includes a laser irradiation means and a cooling means that is not required in any of Groups I-IV, VI and VIII.

Group VI is directed to a system/method with a special technical feature of a scribing line forming means that includes a cutter that is not required in any of Groups I-V and VIII.

Group VII is directed to a system/method with a special technical feature of a multiple scribing line forming means that is not required in any of Groups I-VI and VIII.

Group VIII is directed to a system/method with a combination of special technical features including a special technical feature of a specific pressing means configuration in combination with a special technical feature of a scribing line forming means, the combination of which is not required in any of Groups I-VII.

Species Election

6. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

IA – Figure 3a;

IB – Figure 3b;

IC – Figure 3c;

IIA – Figure 4a, 4b;

IIA – Not shown;

IIC – Not shown.

Upon election of one of Groups I or II, Applicant is required, in reply to this action, to elect a single corresponding species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also confirm or identify the claims readable on the elected species, including any claims subsequently added. An

argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

7. The claims are deemed to correspond to the species listed above in the following manner:

Species IA – claims 4,35,52,83;

Species IB – claims 5,36,53,84;

Species IC – claims 6,37,54,85.

Species IIA – claims 10,40,58,88;

Species IIB – claims 11,41,59,89;

Species IIC – claims 12,42,60,90.

Along with claims 1, 30, 49 and 78, the following claim(s) are generic:

Species I – claims 2,3,29,32-34,48,50,51,77,80-82,96.

Species II – claims 8,9,13,14,32,38,39,43,44,56,57,61,62,80,86,87,91,92,96.

8. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons:

Both Species A are directed to a system/method with a special technical feature of a roller(s) that is not required in the other species;

Both Species B are directed to a system/method with a special technical feature of a conveyor(s) that is not required in the other species;

Both Species C are directed to a system/method with a special technical feature of a bearing(s) that is not required in the other species.

9. Because this lack of unity requirement is considered to be complex, a telephone call was not made to request an oral election to the above restriction requirement.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark F. Dexter whose telephone number is (571)272-

4505. The examiner can normally be reached on Mondays, Tuesdays, Thursdays and Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571)272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/Clark F. Dexter/
Primary Examiner, Art Unit 3724**

cfd
September 14, 2009